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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
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| 09/925,590 | 08/09/2001 | Victor Il'ich Kopp | 1014-9 | 3029 |
| 7590 | | 04/07/2004 | EXAMINER | |
| Edward Etkin, Esq. | | HOFFMANN, JOHN M | | |
| Suite 3C | | ART UNIT | | |
| 4804 Bedford Avenue | | PAPER NUMBER | | |
| Brooklyn, NY 11235 | | 1731 | | |
| DATE MAILED: 04/07/2004 | | | | |

Please find below and/or attached an Office communication concerning this application or proceeding.

| | | | |
|------------------------------|------------------------|---------------------|--|
| Office Action Summary | Application No. | Applicant(s) | |
| | 09/925,590 | KOPP ET AL. | |
| | Examiner | Art Unit | |
| | John Hoffmann | 1731 | |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 26 February 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-40 is/are pending in the application.
- 4a) Of the above claim(s) 30-40 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-29 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Election/Restrictions

Applicant's election of Group I in Paper No. 26 Feb 2004 is acknowledged. Because applicant did not distinctly and specifically point out the supposed errors in the restriction requirement, the election has been treated as an election without traverse (MPEP § 818.03(a)).

Claims 30-40 are withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected invention, there being no allowable generic or linking claim. Election was made **without** traverse in Paper No. 26 Feb 2004.

Specification

The specification is objected to as failing to provide proper antecedent basis for the claimed subject matter. See 37 CFR 1.75(d)(1) and MPEP § 608.01(o). The claims are filled with terms that aren't even mentioned in the specification. There is no mention of any: predefined feeding speed, heating means, feeding means, predefined process temperature, predefined heating location, drawing means, predefined drawing speed, predetermined location, elongated elements, outer cladding material, inner core material, translation means, first speed, second speed, third speed, and activation. This is not a complete list. Applicant is **REQUIRED** to review all of the claims and provide proper antecedent basis for all the claimed subject matter. One must be able to refer to the specification to determine what Applicant is referring to with the claims. It is

unreasonable to expect the public to have to guess/determine what features in the specification correspond to the claimed features.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1-29 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 1: there is no antecedent basis for "said predetermined location" (line 17).

Claim 2: line 8 refers to "a first material" but lines 5-6 already refer to "a first material". It is unclear if this should be a third material or if it is the same first material. The same for "a second material" of line 9.

As indicated in the above objection of the specification, the claims are replete with things that aren't even mentioned in the specification. Claims are interpreted in light of the specification. Since many of the claimed features aren't even mentioned in the specification, it makes it difficult (if not impossible) to be able to interpret the claims in light of the specification. And since one cannot properly interpret the claims, one cannot determine what the claims actually cover and thus the claims fail to distinctly claim the invention.

Examiner cannot understand claims 7-8: Claim 7 requires that the tensioning means can impose a tension prior to the activation of the drawing means. However,

claim 8 requires that this tensioning means includes the securing means for securing the second end of the preform. Turning to page 9, line 13 of the specification, it is the drawing unit which is the securing unit (assumably the securing means). Since claim 7 precludes the use of the drawing means (which is also the securing means), the drawing/securing means cannot be part of the tensioning means as claim 8 requires. Since such appears to be impossible to examiner, it is reasonable to conclude that the claims are not definite. See also the claim objection below. Claim 17 is very similar to 8 and is not understood for the same reason.

Claim 13: There is confusing antecedent basis for "the preform" (and the longitudinal axis there of. Claim 1 refers to the apparatus structure – but there is nothing which indicates that the preform be part of the structure. Rather the broadest reasonable interpretation is that claim1 is directed is an empty machine to which a preform may be added. However, claim 13 indicates that the preform is connected to the wheel and counterweight. Thus examiner is confused as to whether applicant wants the claims to be capable of receiving a preform, nor not (i.e. it is full). Likewise, for claims 11.

From MPEP 2173.05(h):

Alternative expressions are permitted if they present no uncertainty or ambiguity with respect to the question of scope or clarity of the claims. One acceptable form of alternative expression, which is commonly referred to as a Markush group, recites members as being "selected from the group consisting of A, B and C." See Ex parte Markush, 1925 C.D. 126 (Comm'r Pat. 1925).

Presently, at least claims 1-3 have groups which are very similar to the above accepted form, but there is no indication that the group is "consisting of" the members.

Therefore it is impossible for anyone to tell if applicant's group is open or closed to additional members - and thus the claim presents uncertainty or ambiguity with respect to the question of scope of the claim. If the above acceptable form is not desirable for Applicant, Examiner can be telephoned for other appropriate expressions.

35 U.S.C. 112, sixth paragraph states that a claim limitation expressed in means-plus-function language "shall be construed to cover the corresponding structure...described in the specification and equivalents thereof." "If one employs means plus function language in a claim, one must set forth in the specification an adequate disclosure showing what is meant by that language. If an applicant fails to set forth an adequate disclosure, the applicant has in effect failed to particularly point out and distinctly claim the invention as required by the second paragraph of section 112." *In re Donaldson Co.*, 16 F.3d 1189, 1195, 29 USPQ2d 1845, 1850 (Fed. Cir. 1994) (in banc).
The proper test for meeting the definiteness requirement is that the corresponding structure (or material or acts) of a means (or step)-plus-function limitation must be disclosed in the specification itself in a way that one skilled in the art will understand what structure (or material or acts) will perform the recited function. See *Atmel Corp. v. Information Storage Devices, Inc.*, 198 F.3d 1374, 1381, 53 USPQ2d 1225, 1230 (Fed. Cir. 1999)

First it is noted that various claims use means-plus-function language. For example, claim 1 has "feeding means for securing...and feeding", "drawing means for...engaging..., drawing...; and twisting...." Second, the specification does not even use the term "means" – thus one cannot simply turn to the specification to see a specific discussion as to what is meant by the any specific means-plus function term. Third, Examiner could not find any disclosure of any structure used to perform the various functions. Rather, the specification describes most of the invention in terms of its functionality – not in terms of any structure. The specification fails to set forth disclosure which adequately informs one of ordinary skill what the "corresponding structure" is. Furthermore the vagueness prevents one of ordinary skill from making a reasonable interpretation as to what the "equivalents thereof" are.

Claim Objections

Claims 8-10 and 17-18 are objected to under 37 CFR 1.75(c), as being of improper dependent form for failing to further limit the subject matter of a previous claim. Applicant is required to cancel the claim(s), or amend the claim(s) to place the claim(s) in proper dependent form, or rewrite the claim(s) in independent form.

Claim 7 requires that the tensioning means imposes tension **prior** to using/activating the feeding means. Claim 8 requires that this tensioning means includes the securing means. Page 9, line 13 of the specification indicates that the drawing means and the securing means are the same thing. In other words, claim 8 signifies that the drawing means is part of the tensioning means – and this means when the tensioning means is activated, so is the drawing means. But claim 7 requires the opposite - that the drawing means is not activated. Claim 8 is of a scope mutually exclusive of that of claim 7: claim 8 doesn't further limit claim 7 – it takes it to a completely different scope. The drawing means can be both non-activated and activated simultaneously. The same applies to claim 17. Claims 8-10 and 17-18 are not further treated on their merits.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application

by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical Amendments Act of 2002 do not apply when the reference is a U.S. patent resulting directly or indirectly from an international application filed before November 29, 2000. Therefore, the prior art date of the reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

Claims 1- 3, 7, 19-21 and 28-29 are rejected under 35 U.S.C. 102(e) as being anticipated by Onishi 6076376.

The present claims use means-plus-function language, thus invoking 35 USC 112 6th paragraph. As indicated above, Examiner cannot ascertain what the statutory "corresponding structure" for the various means is. Therefore, Examiner is interpreting the various means plus function limitations as encompassing any structure which can perform the specific function, or can be used in part to perform the specific function. Likewise, as indicated in the objection to the specification: many claimed features are not even mentioned in the specification, so Examiner can only guess as to what is actually being claim in many instances.

Claim 1 calls for an apparatus which has a feeding means and a drawing means. See col. 4, lines 43-67 which discloses feeding, drawing, and twisting. It is inherent that there is structure for doing these things. As to the securing and engaging: it is inherent that the feeding means and drawing means can be used to secure and engage as

claimed. It is noted that things such as securing, feeding, engaging, drawing and twisting are all intended use limitations and do not import much in terms of structural limitations.

Claim 2 is directed to intended use limitations and do not significantly further limit the structure of claim1. A recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim See *In re Casey*, 152 USPQ 235 (CCPA 1967) and *In re Otto*, 136 USPQ 458, 459 (CCPA 1963).

Claim 3: see col. 8,lines 64-66.

Claim 7: Looking to figure 1 of Onishi:

Claims 19-20 are inherently met. One cannot deviate from the stated equations without destroying or creating mass.

Claim 21: the creation of a particular heat distribution is method step – it doesn't require any structural limitations. Furthermore, it is an intended use limitation. IN other words, even applicants heating means can be used to create a non-flat heat distribution. For example, if there is a draft in the room, the temperature profile can be different from what the design calls for. A recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art.

Claims 28-29: feature 110 of figure 6 of Onishi is deemed to be the heating chamber. The heat distribution is an intended use/method limitation. Claim 29 is clearly met.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 22-26 is rejected under 35 U.S.C. 103(a) as being unpatentable over Onishi.

It would have been obvious to use insulation with the Onishi heat apparatus so as to maintain heat within the furnace. The use of insulation to maintain heat is a well known practice. The additional limitations of claim 23 and 25 are method limitations, not structure. The heater is the first heat control means, and the insulation is the second heat control means for claims 23-24. For claims 25-26, the heater is the first heat control means and the insulation is the third heat control means: there being no required second heat control means.

Claims 4-6, 27 and 15-16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Onishi as applied to claim 3 above, and further in view Blais 6138480 and Applicant's prior art teaching (hereinafter referred to as PAT) in the first paragraph on page 10 of the specification.

Onishi does not teach the movement of the feeding means or the drawing means. Blais teaches such in the paragraph spanning cols. 2-3 and col. 5, lines 8-29. The Blais gripper is a drawing means and feature 6 is the feeding means. It would have been obvious to use the Blais method of starting the Onishi process, because the Blais method saves time and materials (col. 2, lines 29-32). However Blais does not disclose a translation means. The PAT discloses that such as translation device is well known in the art. It would have been obvious to use the well known translation device, because it is a well known means for moving features as claimed.

Claim 5: it would have been obvious to have a controlling means to operate the process/apparatus because it could be done more precisely than doing it by hand. Alternatively, hand knobs, switch or the like are deemed to be part of a control unit

Claim 6: in addition to the above modifications, it would have been obvious to have the heating means movable as well, so that one can easily move it if so desired. One would recognize the value of a robust apparatus that can be adjusted so as to accommodate a wide range of differently sized preforms. IT would be further obvious to have the controller be able to move the various means at any desired speed.

Claim 27: The steps recited in claim 27 are method steps, and not structure. It would have been obvious to have the structure control the speeds and temperatures as

desired, so that one can perform routine experimentation to determine the optimal processing parameters. And temperature and speeds are important variables that one would want to be able to adjust to find their optimal values.

Claim 15 is clearly met.

Claim 16 does not add any additional structural limitations and thus is also met.

Claims 13-14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Onishi as applied to claim 7 and further in view of Examiner's bicycle and weight lifting set.

Examiner takes Official notice that he had a bicycle and removed the tire and inner tube from a wheel of the bicycle and also owned a weight set in the early 1990's.

As indicated above, Examiner is uncertain as to whether the claims require that the preform be part of the apparatus. The broadest reasonable interpretation would be that the preform is not part of the apparatus. Rather, that the claims are directed to an empty apparatus that can receive a preform for drawing

Claims do not automatically require any proximity between the features. And it would be improper for the Office to arbitrarily designate that the claims require any proximity between the features – applicants have the right to claim such, if so desired. For example, a claim can be directed to a ground station and an orbiting satellite thousands of miles away. Likewise, The present claims do not require the wheel and counterweight to be near the feeding means and drawing means. For example, one can arrange the two axis to be perpendicular and then transport the preform to the rest

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of the apparatus that is thousands of miles away. Examiner's tubeless wheel was capable of supporting one of Examiner's 2.5 pound weights that counterweighs a 2.5 preform, and then disconnecting the weights and arranging the axes so they are perpendicular. One could also transport the preform to the Onishi apparatus.

Claim 14 only has method limitations and no additional structure.

Conclusion

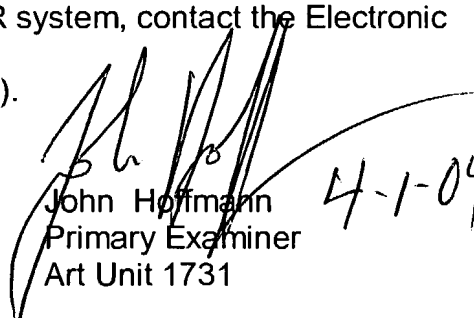
Although it is Office policy to conduct a complete search and provide the Applicant with the best art, Examiner could not reasonably do so with the present application because of the numerous problems understanding what the claims. And given all the functional language in the claims and very few structural limitations, any patentable invention appears to lie in methods, and not in the broadly claimed apparatus which reads on innumerable prior art references.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to John Hoffmann whose telephone number is (571) 272 1191. The examiner can normally be reached on Monday through Friday, 7:00- 3:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Steve Griffin can be reached on 571-272-1189. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


John Hoffmann
Primary Examiner
Art Unit 1731

4-1-04

jmh